

1 **UNITED STATES DISTRICT COURT**
2 **FOR THE EASTERN DISTRICT OF TEXAS**
 TYLER DIVISION

3 NETWORK-1 SECURITY SOLUTIONS,
4 INC., a Delaware corporation,

5 Plaintiff,

6 vs.

7 CISCO SYSTEMS, INC., a California
8 corporation; CISCO-LINKSYS, L.L.C., a
9 California Limited Liability Company;
10 ADTRAN, INC., a Delaware corporation;
11 ENTERASYS NETWORKS, INC., a
12 Delaware corporation; EXTREME
13 NETWORKS, INC., a Delaware corporation;
14 FOUNDRY NETWORKS, INC., a Delaware
15 corporation; NETGEAR, INC., a Delaware
16 corporation; 3COM CORPORATION, a
17 Delaware corporation,

18 Defendants.

Case No. 6:08cv030-LED

ORAL ARGUMENT REQUESTED

19 **DEFENDANTS' REPLY IN FURTHER SUPPORT OF THEIR MOTION FOR**
20 **PARTIAL SUMMARY JUDGMENT OF INVALIDITY FOR INDEFINITENESS**
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TABLE OF CONTENTS

TABLE OF CONTENTS..... i

TABLE OF AUTHORITIES ii

I. INTRODUCTION 1

II. ARGUMENT 1

 A. An Algorithm Must Be Disclosed For The “Control Means” Element. 1

 B. The Specification Does Not Disclose A Two-Step “Comparing” Algorithm. 5

 C. Even With A Two-Step “Comparing” Algorithm, Claim 1 Is Indefinite. 9

 D. In Failing To Identify A Power Source, Claim 9 Is Indefinite 10

III. CONCLUSION..... 10

TABLE OF AUTHORITIES

Federal Cases

<i>Alcatel USA Sourcing, Inc. v. Microsoft Corp.</i> , No. 6:06 CV 499, 2008 WL 3914889, at *17-18 (E.D. Tex. Aug. 21, 2008)	4, 5
<i>Aristocrat Techs. Austl. Pty. Ltd. v. Int'l Game Tech.</i> , 521 F.3d 1328, 133 (Fed. Cir. 2008).....	2, 3, 6, 8, 9
<i>Atmel Corp. v. Information Storage Devices, Inc.</i> , 198 F.3d 1374, 1378 (Fed. Cir. 1999).....	10
<i>Biomedino, LLC v. Waters Technologies Corp.</i> , 490 F.3d 946, 953 (Fed. Cir. 2007).....	6
<i>Blackboard, Inc. v. Desire2Learn, Inc.</i> , 574 F.3d 1371, 1385 (Fed. Cir. 2009).....	6, 8, 9
<i>Budde v. Harley-Davidson, Inc.</i> , 250 F.3d 1369, 1376 (Fed. Cir. 2001).....	9
<i>Harris Corp. v. Ericsson Inc.</i> , 417 F.3d 1241, 1253 (Fed. Cir. 2005).....	4, 5, 6
<i>Jeneric/Pentron, Inc. v. Dillon Co., Inc.</i> , 1999 U.S. Dist. LEXIS 6990 (D. Conn. 1999), aff'd, 205 F.3d 1377, 54 USPQ2d 1086 (Fed. Cir. 2000).....	10
<i>Med. Instrumentation & Diagnostics Corp. v. Elekta AB</i> , 344 F.3d 1205 (Fed. Cir. 2003).....	4
<i>Net MoneyIN, Inc. v. Verisign, Inc.</i> , 545 F.3d 1359 (Fed. Cir. 2008).....	8
<i>S3, Inc. v. Nvidia Corp.</i> , 259 F.3d 1364 (Fed. Cir. 2001).....	4
<i>Union Pacific Resources Company v. Chesapeake Energy Corporation</i> , 236 F.3d 684, 691-92 (Fed. Cir. 2001)	9

Federal Statutes

35 U.S.C. § 112.....	1, 2, 10
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Other Authorities

U.S. Patent No. 6,218,930.....	2
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I. INTRODUCTION

Network-1's contention that an algorithm is *only* required when *only* a microprocessor is disclosed as corresponding structure to a means-plus-function claim element is contrary to the established precedents of the Federal Circuit and of this Court. Contrary to Network-1's assertion, whenever the corresponding structure for a means-plus-function element includes a microprocessor that is involved in performing the recited function, the patent must disclose an algorithm, or the claim is indefinite. Network-1 does not dispute that a microprocessor is corresponding structure to the "control means" element of claim 1 and performs the recited function of that element. Because the '930 patent fails to disclose an algorithm for the microprocessor to perform that function, claim 1 is indefinite.

Network-1's fallback position that if an algorithm is required, the '930 patent discloses a two-step algorithm that simply "compares" a detected voltage with a preselected condition also fails because Network-1 fails to identify anywhere in the patent that discloses or even suggests such an algorithm. At most, Network-1's arguments merely suggest a person of ordinary skill could devise such an algorithm, but the law requires more -- the patent must actually disclose the algorithm. What the patent actually discloses, while not an algorithm, demonstrates that whatever algorithm might be devised must necessarily involve a complex differentiation of several different voltage conditions -- not a simple comparison. Claims 1 and 2 are therefore indefinite.

With respect to claim 9, the claim fails to distinguish which power source is the origin for the voltage that is continued to be sensed. Therefore, the claim fails to particularly point out the invention being claimed and is indefinite.

II. ARGUMENT

A. An Algorithm Must Be Disclosed For The "Control Means" Element.

Network-1's opposition is based on the premise that to meet the requirements of 35 U.S.C. § 112, ¶ 6 for the "control means" element, the '930 patent need not disclose an algorithm because it discloses "*some* structure" corresponding to the "control means" that is in addition to a microprocessor. (Network-1 Opp. at 2-3, 8.) That premise is fundamentally flawed as a matter of fact and of law.

1 Initially, as defendants' technical expert, Dr. Colwell, explained, a person of ordinary skill in
2 the art understands that by itself and without programming or an algorithm, a microprocessor is not
3 capable of performing any function, and that is true whether the microprocessor stands alone or is
4 combined with other structure. (See Defendants' Motion, Ex. 3, Declaration of Robert F. Colwell
5 Regarding Claim Construction of U.S. Patent No. 6,218,930 ("Colwell Dec.") at ¶¶ 72, 84, 77.)
6 Network-1 does not dispute these central facts, and therefore cannot dispute that without an
7 algorithm for the microprocessor corresponding to the "control means," the combination of the
8 microprocessor, A/D converter, and switch cannot perform the recited function of the "control
9 means," i.e., "to control power supplied by said secondary power source to said access device in
10 response to a preselected condition of said voltage level."¹ Because the microprocessor, A/D
11 converter, and switch cannot perform the recited function of the "control means" without an
12 algorithm, and because the '930 patent discloses no algorithm, the '930 patent does not comply with
13 the requirements of 35 U.S.C. § 112, ¶ 6, even though it discloses "some" structure corresponding to
14 the "control means."

15 Network-1's contention also is clearly contrary to the Federal Circuit's *Aristocrat* decision.
16 In *Aristocrat*, the Federal Circuit explained that the reason an algorithm must be disclosed for a
17 general purpose microprocessor or computer corresponding to a means-plus-function element is
18 "because general purpose computers can be programmed to perform very different tasks in very
19 different ways." *Aristocrat Techs. Austl. Pty. Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 133 (Fed. Cir.
20 2008). Accordingly, "simply disclosing a computer as the structure designated to perform a
21 particular function does not limit the scope of the claim to 'the corresponding structure, material, or
22 acts' that perform the function, as required by section 112, par. 6." *Id.* (emphasis in original).
23 Network-1's contention that no algorithm is required when a patent merely discloses "some"
24 structure in addition to a microprocessor is completely contrary to *Aristocrat* because, even with
25 "some" additional structure, to the extent the microprocessor is involved in performing the claimed
26

27 ¹ Network-1's "some structure" contention also is illogical and could lead to patent drafting mischief because the mere
28 disclosure of some generic structure, like a connecting wire, that adds nothing to the microprocessor's ability to perform
the recited structure, nevertheless would make it unnecessary to disclose an algorithm. A clever draftsman could thus
effectively claim functionality while avoiding the requirements of § 112, par. 6.

1 function, it (and hence the entire structure) can still be programmed to perform very different tasks
2 in very different ways, and therefore the scope of the claim is not limited to “the corresponding
3 structure, material, or acts’ that perform the function, as required by section 112, par. 6.” *Id.*²
4 Network-1’s contention that the ‘930 patent’s disclosure of the A/D converter and switch in addition
5 to the microprocessor “avoid[s] the Federal Circuit’s concern of ‘purely functional claiming’”
6 (Network-1 Opp. at 4) is therefore contrary to *Aristocrat*, and is erroneous as a matter of law.³

7 Network-1 also reads the holding of *Aristocrat* too narrowly. *Aristocrat* did not hold that an
8 algorithm need be disclosed *only* when a general purpose microprocessor or computer is the *only*
9 disclosed corresponding structure. In *Aristocrat*, a microprocessor was the only disclosed structure,
10 and the holding in the case thus applies to that situation. However, neither *Aristocrat* nor any other
11 case cited by Network-1 suggests that an algorithm is not also required to be disclosed when a
12 general purpose microprocessor or computer is *part* of the disclosed corresponding structure.
13 Indeed, for the reasons explained above, and based on the Court’s reasoning in *Aristocrat*, it simply
14 makes no sense to require disclosure of an algorithm only when a microprocessor or computer is the
15 *only* disclosed corresponding structure. If a microprocessor is structure that corresponds to a means-
16 plus-function clause, either alone or with additional structures, this structure will not perform a
17 claimed function without an algorithm because a microprocessor without programming performs no
18 function.

19 Network-1’s argument that if the only disclosed structure were an A/D converter or a switch,
20 either component alone would be sufficient to avoid purely functional claiming, is plainly flawed.
21 Network-1 does not and cannot contend that the A/D converter and switch would be sufficient,
22 without more, to perform the recited function of the “control means”; indisputably, the
23 microprocessor, programmed to perform an algorithm, is necessary to direct the A/D converter and
24 switch what to do and when. In other words, in the context of the ‘930 patent, the disclosure of the

26 ² Network-1 does not contest Dr. Colwell’s explanation that the microprocessor could be programmed to perform the
claimed function of the “control means” in a number of different ways. (Colwell Decl. ¶ 83.)

27 ³ Network-1’s related contention that the disclosure of the A/D converter and switch means the “control means” is not
28 “implemented as a general purpose microprocessor” is simply wrong. Network-1 does not dispute that the
microprocessor is involved in performing the recited function of the “control means.” Therefore the “control means” *is*
implemented as a general purpose microprocessor.

1 A/D converter and switch do not avoid the concern of functional claiming because neither operates
2 independently of the microprocessor. Indeed, the '930 specification describes that the A/D converter
3 is not separate structure **but is part of the microprocessor unit itself** (“[d]etector 22 includes an A/D
4 converter and microprocessor control unit 24”). The specification further describes that the “control
5 unit” operates “a detection circuit ... with shunting switch 28,” which is “internal software
6 controlled.” Col. 2:59-65. The disclosure of these structures as part of or as controlled by the
7 microprocessor only serves to reinforce that the microprocessor is the heart of the “control means.”⁴

8 Network-1’s reliance on *Alcatel* and *Harris* to support its contention is misplaced. In *Alcatel*,
9 the Court found the programming or algorithm associated with a processor to be part of the
10 corresponding structure of a means-plus-function element when the processor was the only
11 corresponding structure, and when it was only part of the corresponding structure. Network-1
12 focuses on the *Alcatel* Court’s decision with respect to the “means for determining a specific
13 address” element (*see* Network-1 Opp. at 7-8), but the Court’s decision on that element does not
14 support Network-1. The Court determined that the recited function for the element was
15 “determining a specific address,” and then found the specification disclosed two possible
16 corresponding structures, both of which included a message processor 406. The first structure
17 applied when a specific address was provided in a received data message, and the second structure
18 applied when a generic address was provided in the received message. For the first structure, the
19 Court found the message processor 406 determined the specific address “by **reading** the data or
20 message,” and that the corresponding structure was therefore “the message processor **programmed**
21 **to read the address from the message.**” 2008 U.S. Dist. LEXIS 64351 at *49-51 (emphasis added).
22 The first structure therefore included the message processor 406 as the only hardware structure, and
23 the algorithm “**programmed to read** the address from the message.”

24 For the second structure, the Court found that “[t]o perform the function, message processor
25 406 **transmits** the data or message to locator module 408 associated with the mass memory 410. The
26 locator module reads the specific address from a lookup table stored in the mass memory 410 and

27 ⁴ Network-1’s heavy reliance on *S3, Inc. v. Nvidia Corp.*, 259 F.3d 1364 (Fed. Cir. 2001), and *Med. Instrumentation &*
28 *Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205 (Fed. Cir. 2003), is misplaced. In neither case was a generic,
programmable microprocessor or computer part of the structure corresponding to a means-plus-function element.

1 *provides* that address to message processor.” The Court concluded that the corresponding structure
2 was “message processor 406 *using* locator module 408 that uses a lookup table stored in mass
3 memory 410.” *Id.* at *51-52 (emphasis added). For the second structure, therefore, even though the
4 message processor was only part of the corresponding hardware structure, the Court found the
5 structure to include the algorithm of the message processor “using” the locator module to perform
6 the claimed function.⁵ The *Alcatel* decision therefore does not support Network-1’s contention that
7 no algorithm is required when a microprocessor is only part of the disclosed corresponding structure.

8 Similarly, the *Harris* Court specifically found that the corresponding structure for the recited
9 “time domain processing means” was actually two separate processors – a “support processor,” and
10 a “fast array processor,” each of which performed part of the recited function. 417 F.3d at 1254.
11 Nevertheless, the Court found that the corresponding structure must include the complete “data
12 recovery algorithm” which was carried out in part by each of the processors. *Id.* Thus, *Harris* also
13 confirms that even when a processor is only part of the disclosed corresponding hardware structure
14 for performing the claimed function, a disclosed algorithm for the processor must be included as part
15 of the corresponding structure.

16 **B. The Specification Does Not Disclose A Two-Step “Comparing” Algorithm.**

17 Network-1’s contention (Network-1 Opp. at 9) that the person of ordinary skill in the art
18 would understand the ‘930 patent to disclose a two-step algorithm, in which the first step is
19 “comparing the voltage on the data signaling pair with a preselected condition,” finds no support in
20 the patent or in the law. Network-1 contends that Figure 1 of the ‘930 patent and the corresponding
21 text at col. 2, lines 59-65 discloses its proposed algorithm, but Figure 1 is merely a schematic
22 diagram that even named inventor Mr. Katzenberg admits does not disclose an algorithm, i.e., a
23 series of steps, to accomplish the claimed function of the “control means.” (*See* Defendants’
24 Motion, Ex. 4 (excerpts from the deposition of Boris Katzenberg, taken May 12 and 13, 2009 at 396-
25 98, 400, 403-04).)

26
27 ⁵ The recited function in *Alcatel*, i.e., “determining a specific address,” required only a simple algorithm to perform,
28 unlike the function at issue in this case, which requires making a powering decision in response to a preselected
condition where the specification describes three different voltage conditions that can be detected and that signify
different powering situations.

1 The corresponding text of the ‘930 specification also does not disclose an algorithm. The
2 text merely discloses an “A/D converter and microprocessor control unit 24, operating a detection
3 circuit” and “an internal software controlled switch” 28. Col. 2:59-65. This cryptic disclosure
4 merely identifies certain components. It does not describe any steps for the microprocessor to
5 operate the detection circuit, let alone an algorithm or series of steps to carry out the recited function
6 of the “control means.” *Cf. Aristocrat*, 521 F.3d 1335 (rejecting argument that patent figures and
7 related text were algorithms; “The figures, tables, and related discussion . . . are not algorithms.
8 They are simply examples of the results of the operation of an unspecified algorithm.”). At most, the
9 specification describes components that *could be operated* on by a microprocessor using any number
10 of different algorithms, but without disclosing any such algorithm

11 Network-1 and its technical expert Dr. Knox assert that the person of ordinary skill in the art
12 would understand the ‘930 specification discloses a microprocessor that compares the voltage on the
13 data signaling pair with a preselected condition and if they match closes switch 28. (Network-1
14 Opp. at 10; Knox Decl. ¶42.) But, Dr. Knox does not, and indeed cannot, point to any place in the
15 specification that actually says the microprocessor “compares” the detected voltage to a preselected
16 condition, or closes the switch in response to such a comparison. Indeed, Dr. Knox does not point to
17 anything in the specification from which those steps can even be reasonably inferred. Instead,
18 Network-1 and Dr. Knox invite the Court to do precisely what the Federal Circuit has again recently
19 cautioned against: substituting what a person of ordinary skill *could* devise as a possible algorithm
20 for a failure of *actual* disclosure in the specification. *See Biomedino, LLC v. Waters Technologies*
21 *Corp.*, 490 F.3d 946, 953 (Fed. Cir. 2007) (“The inquiry is whether one of skill in the art would
22 understand the specification itself to disclose a structure, not simply whether that person would be
23 capable of implementing that structure.”).⁶ In so doing, Network-1 invites legal error by
24 fundamentally confusing the definiteness requirement with the enablement requirement. *See*
25 *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009) (cautioning against

26 ⁶ Network-1 argues that the ‘930 patent discloses the proposed two-step algorithm at the level of detail required
27 by the Federal Circuit, citing *Harris*, 417 F.3d at 1254. (Network-1 Opp. at 9.) However, in *Harris*, the Court found the
28 specification specifically disclosed a two-step algorithm in the text and figures. *See* 417 F.3d at 1254-55. In stark
contrast, the ‘930 patent provides *no* disclosure from which Network-1’s proposed two-step algorithm can be even
generalized.

1 “conflate[ing] the definiteness requirement of section 112, paragraphs 2 and 6, and the enablement
2 requirement of section 112, paragraph 6”; “The fact that an ordinarily skilled artisan might be able to
3 design a program . . . goes to enablement. The question before us is whether the specification
4 contains a sufficiently precise description of the ‘corresponding structure’ to satisfy section 112,
5 paragraph 6, not whether a person of skill in the art could devise some means to carry out the recited
6 function.”).

7 In fact, what the ‘930 specification *actually* discloses completely undermines Network-1’s
8 contention that the person of ordinary skill in the art would understand the ‘930 patent discloses a
9 two-step algorithm in which the first step is simply to compare the detected voltage to a preselected
10 condition. The ‘930 patent *actually* discloses that *three different* voltage conditions can be
11 “determined” and that each “identify” whether or not a particular type of device is able to receive or
12 not receive power. The first two, “fixed” and “no” voltage drops, identify different types of
13 equipment that are defined as not being able to accept remote power. Only the last, a “varying”
14 sawtooth voltage level, identifies a type of equipment that can accept remote power. (See Ex. 1, col.
15 3:2-19.) The three voltage condition description necessarily requires more than a simple comparison
16 of *whatever* voltage condition is detected to a preselected condition to determine if a connected piece
17 of equipment is able to receive remote power. It actually requires a more complex decision-making
18 process which can differentiate between at least three different conditions and then decide whether to
19 supply power based on that differentiation. (See Colwell Dec. ¶ 79.) If the ‘930 patent was intended
20 to disclose a simple two-step comparison algorithm, it easily could have said that, but it does not.
21 Contrary to Network-1’s argument therefore, the ‘930 patent would not reasonably suggest to a
22 person of ordinary skill in the art a simple two-step “comparing” algorithm, but rather a more
23 complex algorithm, which it does not disclose. (See Colwell Dec. ¶¶ 79, 81.)

24 Network-1 deceptively twists Dr. Colwell’s declaration in an attempt to support its two-step
25 algorithm contention. (Network-1 Opp. at 10.) Contrary to Network-1’s characterization, however,
26 Dr. Colwell did not opine that the person of ordinary skill in the art would understand the ‘930
27 specification *discloses* a two-step algorithm. Rather, Dr. Colwell explained that a person of ordinary
28 skill in the art would understand that the microprocessor would need to implement an algorithm to

1 determine if the detected voltage matches a preselected condition and based on that determination
2 take the necessary action to control power. (Colwell Dec. ¶¶76.) That is very different from saying
3 that the specification discloses a two-step algorithm, or any algorithm. Indeed, Dr. Colwell further
4 explained that the ‘930 patent does *not* disclose any algorithm, let alone a two-step algorithm
5 (Colwell Dec. ¶¶ 73-74, 77-78, 81, 83), and that in fact many algorithms are possible. (Colwell Dec.
6 ¶¶ 79, 83.)

7 Finally, Network-1 misstates this Court’s claim construction of “control means” in the *D-*
8 *Link* case. Network-1 argues that the Court did not require an algorithm for the “control means” in
9 the *D-Link* case and alleges that the Court recognized the “control means” performs a two-step
10 algorithm. (Network-1 Opp. at 10.) This argument is erroneous for at least three reasons. *First*, the
11 Court did not consider in *D-Link* whether an algorithm was part of the required structure of the
12 “control means” because neither party suggested or even raised that issue. That is perhaps not too
13 surprising given that the Federal Circuit did not issue the decisions in *Aristocrat*, *Net MoneyIN*, or
14 *Blackboard* until after the Court had already issued its claim construction. In any event, the parties’
15 failure to point out the lack of any algorithm in *D-Link* plainly does not bind the defendants in this
16 case.

17 *Second*, the Court in *D-Link* did not even consider let alone decide whether the ‘930
18 specification discloses a two-step algorithm as Network-1 argues, or indeed any algorithm. In the
19 section of the Court’s claim construction decision that Network-1 quotes, the Court found that “A/D
20 converter and microprocessor 24 activate switch 28 to the closed position *when a preselected*
21 *condition of the voltage level is detected and therefore is responsive to that condition*” (emphasis
22 added). The Court’s statement is not a recognition that the specification discloses a two-step
23 “comparing” algorithm, or any algorithm, but merely a restatement of the “control means” function
24 recited in the claim: “to control power ... in response to a preselected condition of said voltage
25 level.” The Federal Circuit has made clear that simply restating the claimed function in the
26 specification does not substitute for disclosing an algorithm to carry out the function, or save a claim
27 from a finding of indefiniteness, and so it is highly doubtful that is what the Court did in *D-Link*.

1 See *Aristocrat*, 521 F.3d at 1334 (language in the specification that “simply describes the function to
2 be performed” does not suffice as an algorithm); *Blackboard*, 574 F.3d at 1384 (same).

3 Third, in *D-Link*, the Court did not consider the three-voltage-state disclosure of the ‘930
4 specification, as it would have if it were determining whether the ‘930 patent discloses an algorithm
5 and, if so, what it is. Taking that description into account, the Court has a compelling reason to
6 conclude that no person of ordinary skill in the art could reasonably determine the ‘930 patent
7 discloses Network-1’s simple two-step “comparing” algorithm.

8 **C. Even With A Two-Step “Comparing” Algorithm, Claim 1 Is Indefinite.**

9 If it is found that the ‘930 patent discloses Network-1’s proposed two-step algorithm, then
10 the “comparing” step constitutes a substantive limitation of claim 1, which must be considered in
11 determining the claim’s scope. See *Aristocrat*, 521 F.3d at 1331 (“The scope of that [means-plus-
12 function] claim limitation had to be defined by the structure disclosed in the specification plus any
13 equivalents of that structure”); *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed. Cir.
14 2001) (“It is not until the structure corresponding to the claimed function in a means-plus-function
15 limitation is identified and considered that the scope of coverage of the limitation can be
16 measured.”). However, the scope of claim 1 cannot be determined because the ‘930 patent provides
17 no guidance as to what it means to “compare” the detected voltage condition and preselected
18 condition. Network-1 does not point to any explanation, and does not dispute Dr. Colwell’s
19 explanation that “comparing” can mean many different things to the person of ordinary skill in the
20 art. (Colwell Dec. ¶ 83) In the absence of any guidance or explanation in the ‘930 patent to the
21 meaning of “compare,” the scope of claim 1 remains indefinite. See *Union Pacific Resources*
22 *Company v. Chesapeake Energy Corporation*, 236 F.3d 684, 691-92 (Fed. Cir. 2001) (finding under
23 very analogous facts that a claim element “comparing” two sets of characterizing data was indefinite
24 where the specification provided no explanation of the mathematical manipulation required to
25 compare the data, and where “comparing” could have other meanings to a person of ordinary skill in
26 the art).

1 **D. In Failing To Identify A Power Source, Claim 9 Is Indefinite.**

2 Network-1's opposition is based on the premise that one of ordinary skill in the art would
3 easily understand claim 9, and claim 6 from which it depends. As evidence, Network-1 cites the
4 declaration of Dr. Knox, who states that "[t]he claim language is clear: the 'voltage level on the data
5 signaling pair,' which is sensed in claim 6, is the voltage that continues to be sensed in dependent
6 claim 9.'" (Knox Dec. ¶ 39 - 41.) A dependent claim "must be interpreted to encompass each of its
7 own elements as well as any additional elements recited in the referenced claim." Jeneric/Pentron,
8 Inc. v. Dillon Co., Inc., 1999 U.S. Dist. LEXIS 6990 (D. Conn. 1999), aff'd, 205 F.3d 1377, 54
9 USPQ2d 1086 (Fed. Cir. 2000). Claim 6 establishes two power sources, a main and secondary
10 power source, but Network-1 fails to demonstrate how Claim 9 establishes which of these serves as
11 the source for the sensed voltage.

12 Network-1 states it cannot identify a power source because this limitation is absent from
13 claim 9. But in failing to incorporate a power source limitation into claim 9, the claim fails to
14 "particularly point out and distinctly claim the subject matter which the patentee regards as his
15 invention." Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1378 (Fed. Cir. 1999).

16 **III. CONCLUSION**

17 Defendants respectfully request that this Court enter judgment declaring claims 1, 2, and 9 of
18 the '930 patent invalid as indefinite under 35 U.S.C. § 112, ¶ 2.

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Respectfully submitted,

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